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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,205	01/20/2006	Uri Arnin	1454VASUS	9521

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08/06/2008

EXAMINER

SCHILLINGER, ANN M

ART UNIT	PAPER NUMBER
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3774

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,205	Applicant(s) ARNIN ET AL.	
	Examiner ANN SCHILLINGER	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 8-13, and 18 are rejected under 35 U.S.C. 102(b) as being unpatentable over Reiley et al. (U.S. Pat. No. 6,248,110). Reiley et al. discloses the following of the claimed invention as shown in Figures 6 and 7): an elastomeric sheath (56) surrounding an outside portion of a rod (50), a portion of said sheath being arranged for sliding along said rod; and a sheath compactor (100) adapted to slide a portion of said sheath along said rod from a first position to a second position, wherein in the first position said sheath is in a non- expanded orientation and in the second position said sheath is in an expanded orientation wherein folds of said sheath expand radially outwards from said outside portion of said rod, wherein said elastomeric sheath surrounds the outside portion of the rod both in the non-expanded and expanded orientations and wherein said folds in the expanded orientation comprise a plurality of crests and troughs (col. 11, lines 7-18). The rod comprises a removable portion (col. 8, lines 52-60). It is also flexible (col. 8, lines 9-20) and capable of being fastened together and forming an arcuate shape.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. in view of Davison (U.S. Pat. No. 6,530,926). Reiley et al. discloses the claimed invention except for the use of a stopper. Davison teaches a vertebral prosthesis that uses a stopper in col. 9, line 58 through col. 10, line 4 for the purpose of protecting the end of the inserted device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stopper in order to protect the end of the inserted device.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. in view of McNamara et al. (U.S. Pat. No. 5,147,370). Reiley et al. discloses the claimed invention except for the use of a fastening ring. McNamara et al. teaches a biological prosthesis that uses a fastening ring in column 9 for the purpose of securely connecting parts of the device together. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a fastening ring in order to securely connect parts of the device together.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. in view of Foley et al. (U.S. Pat. No. 6,676,665). Reiley et al. discloses the claimed invention except for the rod being made of a shape memory material. Foley et al. in col. 9, lines 30-40, teaches spinal instrumentation with its parts made of a shape memory alloy so that if the rod's shape is deformed when it is being used, it will return to its original shape and be available for use again. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a shape memory material when constructing the rod so that the instrument will maintain its original shape.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. in view of Scholten et al. (U.S. Pat. No. 4,969,888). Reiley et al. discloses the claimed invention except for the use of an anchor. Scholten et al. teaches a vertebral prosthesis that uses an anchor in col. 4, lines 55-68 for the purpose of keeping the inserted device in its desired locations. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an anchor in order to keep the inserted device in its desired location.

Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiley et al. in view of Cragg (U.S. Pub. No. 2002/0016583). Reiley et al. discloses the claimed invention except for the use of a guide wire. Cragg teaches tools and methods for procedure in the spine that utilize a guide wire with a stopper end in paragraphs 0113, 0191, and 0213 in order to direct the sheath to its proper position. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a guide wire for the purpose of direct the sheath to its proper position.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/
Examiner, Art Unit 3774

/DAVID J ISABELLA/
Supervisory Patent Examiner, Art Unit 3774